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D. BEIPatent
Attorney's Docket No. 018656-199**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of)
Kyu TAKADA et al) Group Art Unit: 2873
Application No.: 09/865,625) Examiner: James Phan
Filed: May 29, 2001) Confirmation No.: 4105
For: OPTICAL SCANNER)

REQUEST FOR CLARIFICATION OF OFFICE ACTION FAX RECEIVED

Assistant Commissioner for Patents
Washington, D.C. 20231

JAN 03 2003

TECHNOLOGY CENTER 2800

Sir:

The Office Action dated December 31, 2002, sets forth a new requirement for election of species, in addition to those presented in the Office Action dated September 12, 2002. However, Applicants are unable to respond to the requirement as set forth in the Office Action, and therefore request further clarification before a substantive response can be filed.

The Office Action states that the elected species and subspecies contains claims directed to patentably distinct species of the claimed invention. The Action identifies species I as claims 1-4 and 24, and species II as claims 13-15 and 23. Applicants respectfully submit that the identification of species with reference to the claims is not proper, and does not provide them with information sufficient to respond to an election of species requirement. More particularly, MPEP §806.04(e) states: "Claims are definitions of inventions. *Claims are never species... Species are always the specifically different embodiments*" (emphasis in original).

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The next section of the MPEP goes on to state:

Claims to be restricted to different species *must be mutually exclusive*. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which *under the disclosure* are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. (emphasis added)

In describing the appropriate form for an Office Action containing a requirement to elect species, MPEP §809.02(a) states:

(B) Clearly identify each...of the disclosed species... The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively.

The election of species set forth in the Office Action dated December 31, 2002, does not identify species in the manner indicated in the MPEP. Rather, the Office Action only refers to the language of the claims. However, this language does not identify mutually exclusive characteristics that are found in different disclosed embodiments. For example, each of claims 1 and 13, which are referenced in the Office Action, reads upon the embodiments disclosed in each of Figures 1, 2 and 3 of the application. The Office Action has not identified mutually exclusive features of these embodiments that are respectively recited in different ones of the claims. In other words, the Office Action has not identified the different "disclosed" embodiments that are considered to constitute the respective species. Without such an identification, it is not possible for Applicants to elect a single disclosed species, as set forth in the election requirement.

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By dividing the elected claims into two groups, and focusing upon the language of a claim in each group, the form of the Office Action appears to be more along the lines of a restriction requirement, rather than a requirement to elect species. However, if a restriction requirement was intended, the Examiner has not addressed either of the criteria for a proper restriction requirement set forth in MPEP §803. Specifically, he has not identified how the two groups of claims are considered to be independent or distinct, nor how the failure to require a restriction would present a serious burden.

Accordingly, before they are able to substantively respond to the Office Action, Applicants respectfully request clarification whether the Office Action is requiring a restriction between allegedly independent and distinct groups of claims, or requiring election of a single disclosed species. If a restriction requirement is intended, the Examiner is respectfully requested to point out how the two groups of claims are considered to be independent and distinct, so that Applicants can determine whether a traversal would be appropriate. If an election of species is being required, the Examiner is requested to identify the different embodiments that are considered to represent the respective species, as set forth in the MPEP.

Respectfully submitted,
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CERTIFICATE OF TRANSMISSION


Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

I hereby certify that this correspondence, consisting of a Request for Clarification of Office Action, is being transmitted via facsimile to the Patent and Trademark Office Fax No. (703) 308-7722 in connection with the above-identified application.

Respectfully submitted,

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